

**REMARKS**

**I. STATUS OF CLAIMS**

Claim 27 is currently pending; claims 28-114 were previously canceled as being directed to non-elected subject matter. No amendments are provided herein.

**II. REJECTIONS UNDER 35 U.S.C. § 103**

**A. Bhatt in view of Ramin, Samain and Mougin**

The Office newly rejected claim 27, as unpatentable under 35 U.S.C. § 103 over U.S. Patent No. 6,106,808 to Bhatt et al. ("Bhatt") in view of U.S. Patent No. 5,683,681 to Ramin et al. ("Ramin"), WO 98/22077 to Samain et al. ("Samain") and WO 97/25021 to Mougin et al. ("Mougin"). Office Action at page 2. Applicant respectfully disagrees and traverses the rejection for the following reasons.

Based on the Office's rationale, Bhatt discloses compositions of (A) polyurethane resin and (B) at least one film-forming polymer, i.e., a second hair fixative resin such as Gantrez A425, and that these compositions provide spray particle sizes of about 20 to about 150 microns. Office Action at pages 2 and 3. The Office then uses Ramin to teach that "butyl esters of vinylmethylether/maleic anhydride copolymers are film-forming polymers" (i.e., Gantrez A425 is known as a film-forming polymer) and Mougin to teach block copolymers of polyurethane and polysiloxane to meet the claimed phrase "wherein the at least one polycondensate (A) is formed from at least one compound having a silicone skeleton . . . ." *Id.* at page 3. Further, the Office now adds the teachings of Samain directed to particular film forming polymers, such as VS80, i.e., anionic polymer that "is particularly useful for aerosol hair fixing composition as fixing polymer or film-forming polymer. *Id.* However, "[a] prior art reference must be

considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” M.P.E.P. § 2141.03(VI) (citations omitted).

For example, the Office relies upon “(G) Some teaching, suggestion, or motivation in the prior art that would have lead one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention” to support the alleged conclusion of obviousness. M.P.E.P. § 2143. In fact, the Office finds a motivation to modify Bhatt with Mougin and Samain’s teachings by asserting that each of the cited references provide “*superior properties* as film forming agent or film forming additive for hair products and is particularly useful in aerosol form.” *Id.* at page 4. (emphasis added) This sort of rationale does not take into account the cited references as a whole.

Bhatt makes an ambiguous statement to the inclusion of “silicones” as one of the many possible “additives” that are used in “conventional hair spray adjuvants.” Bhatt at Col. 14, ll. 17-26. Without more, the disclosure in Bhatt directed to “additives” is not enough to lead one skilled in the art to substitute Mougin’s polycondensate that includes a silicone chain, i.e., a polycondensate block with the polyurethane and/or polyurea block.

While Bhatt teaches that the polyurethane resin can comprise various reaction components, silicones are not among the suggested components. *Id.* at Col. 7, line 23-Col. 11, line 34. Instead, Bhatt’s disclosure of “silicone” is with respect to its use as an “additive” or “adjuvant,” not as part of the polyurethane resin polymer. It is unclear how one skilled in the art would take a teaching of an additive or adjuvant and utilize it as

part of a complex polymer. Moreover, Mougin says nothing about the deficiencies in Bhatt's polyurethane polymer and in fact, states the opposite, i.e., Mougin highlights the deficiencies of silicone polymers. Mougin at Col. 1, line 9-Col. 3, line 2. Thus, without more guidance, there is no suggestion or teaching from either Bhatt or Mougin to support their combination.

As for Samain, this reference is directed to:

An aerosol device comprising a container containing an aerosol composition comprising a liquid phase (or fluid) containing at least one fixing material in a suitable solvent, a propellant, and a means for distributing the aerosol composition, . . . .

Samain at Abstract. Samain's fixing compositions are akin to the compositions described in the present application at page 1, line 21-page 2, line 18. That passage of the specification details the apparent difficulties in reducing the volatile organic compounds from Samin's compositions (i.e., the use of propellants) by replacing the solvents with water, i.e., "this change of the formulation of hair compositions has the harmful effect of greatly increasing their viscosity."

In order to overcome those difficulties, "the Applicant has discovered, surprisingly and unexpectedly, that it is possible to prepare pump-dispenser bottle devices which satisfy the requirements expressed above, by carrying out a selection, on the one hand, on the cosmetic composition, and, on the other hand, on the means for distributing this composition." Applicant's Specification at page 3, ll. 5-11. Thus, even if Samain allegedly teaches "superior properties" of the particular film forming polymer, the context

from which it is taken does not necessarily translate into “superior properties” in the present invention, and in fact, Applicant discloses as much.

Ramin does nothing to cure the foregoing deficiencies. Indeed, as shown in Example 1, the only time this reference describes a diameter of the composition it is with respect to “beads” having a size ranging from 0.5 to 1.0mm. Absent the improper reliance on Applicant’s disclosure, one could logically conclude that film-forming polymers comprising butyl esters described in Ramin would lead to much larger “beads” rather than a composition having an average diameter less than or equal to 80 microns.

For at least these reasons, the Office fails to establish a *prima facie* case of obviousness and as such, Applicant respectfully request the withdrawal of the rejection.

**B. Mougin and Samain in further view of Bhatt and Malawer**

According to the Office, claim 27 is allegedly unpatentable under 35 U.S.C. § 103 over WO 97/25021 to Mougin et al. (“Mougin”) and WO 98/22077 to Samain et al. (“Samain”), in further view of U.S. Patent No. 6,106,808 to Bhatt et al. (“Bhatt”) and U.S. Patent No. 5,458,871 to Malawer et al. (“Malawer”). Office Action at page 5. The Office asserts that Mougin teaches copolymers of polyurethane and polysiloxane, but does not teach an aerosol device with droplets of 80  $\mu\text{m}$ . *Id.* at page 5. To cure this deficiency, Bhatt is used to teach hair spray compositions with spray particle sizes of about 20 to 150 microns. Malawer is then used to demonstrate that it is generally recognized in the art that small droplet size is desirable. *Id.* In addition, the Office now relies upon Samian to teach particular film forming polymers, such as VS80, i.e., anionic polymer, that “is particularly useful for aerosol hair fixing composition as fixing polymer

or film-forming polymer.” *Id.* Based on those teachings, the Office concludes that it is obvious “to prepare a hair style aerosol composition with the block copolymer of Mougin et al. and the anionic polymer disclosed by Samain et al. as additional film forming agent, in a device that an optimal and desirable droplet size would be generated.” *Id.* at page 6. Applicant respectfully disagrees and traverses this rejection for the following reasons.

Applicant takes issue with the combination of cited references used by the Office and specifically, the combination of Mougin and Samain. The Office clearly relies upon “(G) Some teaching, suggestion, or motivation in the prior art that would have lead one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention” to support an alleged conclusion of obviousness. M.P.E.P. § 2143. In fact, the Office finds a motivation to combine Mougin and Samain by asserting the rationale of *In re Kerkhoven*, i.e., it is prima facie obvious to combine two composition each of which is taught in the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose. Office Action at page 6.

However, neither the facts nor the holding of *In re Kerkhoven* applies to this case. In *Kerkhoven*, the appealed claims were directed to a process for forming a detergent, comprising forming two aqueous slurries, where one slurry was predominantly an anionic detergent and the other was primarily a nonionic detergent; independently or simultaneously drying the slurries; and mixing the resulting products. *See Kerkhoven*, 626 F.2d at 847, 205 U.S.P.Q. at 1070. It was acknowledged that prior art detergents comprised a mixture of anionic fatty acid soaps, anionic detergents, and nonionic

detergents. *Id.* at 848, 205 U.S.P.Q. at 1071. To make the known detergents, all of the ingredients were combined together in one slurry and then spray dried. *Id.*, 205 U.S.P.Q. at 1071. Therefore, the court agreed with the examiner's conclusion that the claims at issue required "no more than the mixing together" of two conventional detergents to make a third detergent composition set forth "prima facie obvious subject matter." *Kerkhoven*, 626 F.2d at 849, 205 USPQ at 1071 (emphasis added).

According to the Office's rationale in the outstanding rejection, it would have been allegedly obvious "to prepare a hair style aerosol composition with the block copolymer of Mougin et al. and with the anionic polymer disclosed by Samain et al. as additional film forming agent . . . ." Office Action at page 6. In this instance, the use of *Kerkhoven's* "mere mixing" holding is misplaced. The facts in *Kerkhoven* involve the mixing of two detergent compositions; the facts based on the Office's rationale involve the selection of a single component from one composition, i.e., the block copolymer of Mougin, and the addition of the anionic polymer disclosed by Samain. Thus, the mixing in *Kerkhoven* of two compositions in their entirety to form a third composition performing the same function is substantially different than the selection of a single component from one composition, and the addition of that component to another composition.

For at least the reasons provided above, the Office fails to establish a *prima facie* case of obviousness based on the combination of Mougin and Samain in further view of Bhatt and Malawer. Accordingly, Applicant respectfully requests that the rejection should be withdrawn.

**III. CONCLUSION**

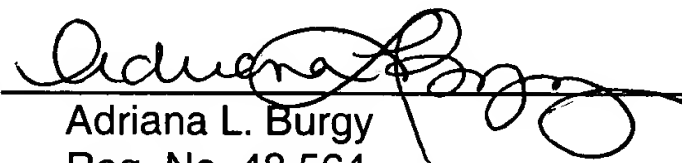
In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: January 28, 2008

By:   
Adriana L. Burgy  
Reg. No. 48,564